

REMARKS / DISCUSSION OF ISSUES

Claims 1 and 3-11 are pending in the application. Claim 11 is new.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 5-7 and 9-10 are rejected under 35 U.S.C. § 102(c) in view of *Tiesler-Wittig* (US Patent Application Publication 2003/0031026). For at least the reasons set forth below, Applicants respectfully submit that this rejection is improper and should be withdrawn.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1, as amended, recites:

A metal halide lamp , comprising:

a cylindrically-shaped discharge vessel along a longitudinal axis, said discharge vessel having a ceramic wall which encloses a discharge space comprising Xe and an ionizable filling, wherein a portion of a surface of the outer bulb facing away from the discharge vessel is shaped as a negative lens, and

a cylindrically-shaped outer bulb surrounding the discharge vessel along the longitudinal axis, wherein the portion with respect to the longitudinal axis encompasses a segment of the outer bulb with a segment angle α in a range between $20^\circ \leq \alpha \leq 110^\circ$.

Embodiments comprising the negative lens with the angular relationship of claim 1 are described in connection with Figs. 3A and 4A, for example.

The Office Action directs Applicants to paragraph [0036] for the alleged disclosure of the angular relationship of the portion and the longitudinal. However, Applicants respectfully submit that this portion of the applied art fails to disclose the segment angle as claimed, but rather the orthogonality of the lenses, which are shown as being planar, and the central axis. There is no segment angle, and especially no disclosure of a segment angle in the range set forth in claim 1.

For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 1, and, as such, a *prima facie* case of anticipation has not been established. Accordingly, Applicants respectfully submit that claim 1 is patentable over *Tiesler-Wittig*. Moreover, claims 3-11, which depend from claim 1 directly or indirectly, are patentable over the applied art.

General Comments on Rejections of Dependent Claims

Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicant believes that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. Applicant does not, however, necessarily concur with the interpretation of any dependent claim as set forth in the Office Action, nor do Applicant concurs that the basis for the rejection of any dependent claim is proper. Therefore, Applicant reserves the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

Date: May 26, 2009

Volentine & Whitt, PLLC
Two Meridian Blvd.
Wyomissing, PA 19610
(610) 375-3513 (v)
(610) 375-3277 (f)